

## REMARKS

Applicant has reviewed the Office Action mailed December 4, 2002. Claims 1, 8, 14, 21, 31, and 35 are being amended by this Response. Support for the amendment may be found throughout the specification and drawings as filed. Specifically, support for the amendment to Claims 1, 8, 14, and 21 may be found in the specification, FIG. 4, step 422, Pg 11, Lines 23-26. Thus, claims 1 through 35 are pending in the application. Applicant hereby requests further examination and reconsideration of the application in view of the following remarks.

Claims 31 and 35 were objected to for containing numerous misspellings. The amendment to claims 31 and 35 has corrected these informalities and withdrawal of the objection is respectfully requested.

### *Claim Rejection – 35 U.S.C. §112*

Claims 31 through 35 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Applicant respectfully disagrees. Claims 32 through 35 depend from independent claim 31, therefore the rejection to claim 31 will be addressed.

Applicant respectfully submits that the Patent Office has failed to establish a *prima facie* case under 35 U.S.C. §112, first paragraph. In particular the Patent Office has failed to establish that the present invention of the instant application as claimed in claims 31, is not supported by the specification. With regards to the 35 U.S.C. §112, first paragraph written description requirement, it has been determined by the courts, “that the scope of the claims must bear a reasonable correlation to the scope of enablement provided by the specification to persons of ordinary skill in the art. In cases involving predictable factors, such as mechanical or electrical elements, a single embodiment provides broad enablement in the sense that, once imagined, other embodiments can be made without difficulty and their performance characteristics predicated by resort to known scientific laws.” *In re Fisher*, 427 F.2d 833, 166 USPQ 24 (C.C.P.A. 1970). (Emphasis added).

The Patent Office states that, “[t]he specification only discloses sending a request for program guide data to the first information handling system from the second information handling system, and transmitting event data to the second system via the first system.” In support of this position the Patent Office offers, “[t]he bi-directional communication via the first and second device (100 and 218 respectively, Fig 2), provides requests from transceiver 220 (of second device) to transceiver 216 (of first device), and EPG data is provided from transceiver 216 to transceiver 220.” Applicant agrees with the Patent Office only to the extent that this is a valid description of a single embodiment of the present invention.

The scope of claim 31 bears a reasonable correlation to the scope of enablement provided by the specification. The second information handling system 218, “is similar to information handling system 100 as described with respect to FIG. 1” (Specification Pg. 6, Lines 9-10). Thus, the second information handling system 218 may be enabled with any and all functionalities of the first information handling system 100. Another relevant passages of the instant application states:

As such, second information handling system 218 typically requires less features and functions than information handling system 100, so that not all of the hardware devices of information handling system 100 may be required, although any one or more of the hardware devices of FIG. 1 may be utilized.

(Specification Pg. 6, Lines 15-19) (emphasis added). Thus, the second information handling system 218 may be enabled with the relevant functionalities needed in order to perform the functions claimed in claim 31.

Further, as stated above, “a single embodiment provides broad enablement” *In re Fisher*, 427 F.2d 833, 166 USPQ 24 (C.C.P.A. 1970). The instant application states, “communications link 224 provides bi-directional communication between information handling system 100 and second information handling system 218.” (Specification Pg. 7, Lines 26-27). Such bi-directional capabilities of the present invention provide a broad enablement which may include the ability to provide requests from the transceiver 216 (of first device), to transceiver 220 (of second device), and EPG data is provided from transceiver 220 to transceiver 216. A bi-direction system of communication is well known in the art and provides predictable factors which allow other embodiments to be

made in reliance on known scientific values. Thus, the direction of communication occurring within a bi-directional system should be read to include not only the embodiment illustrated but other embodiments which can be made without difficulty.

By enabling bi-directional communication between a first and a second information handling systems, providing for the enablement of the first and the second information handling systems in a similar manner, a person of ordinary skill in the art would correctly perceive the scope of enablement of the present invention to include that claimed in claim 31. The Applicant respectfully requests withdrawal of the rejection and allowance of the claim 31.

Claims 32 through 35 are believed to be allowable based on dependence from an allowable claim.

***Claim Rejection – 35 U.S.C. §102***

Claims 1 through 26 were rejected under 35 U.S.C. §102(e) as being anticipated by Darbee et al., U.S. Patent No. 6,130,726 (Darbee). Applicant respectfully disagrees. However, the Applicant has amended claims 1, 8, and 14 to include the limitation of, “in the event the event related program guide data is available, the second information handling system displays the program guide data, and,” as shown in FIG. 4 (step 422) and described in the specification Pg. 11, Lines 24-26 of the instant application. This limitation is not taught or suggested by the Darbee reference. Applicant respectfully requests withdrawal of the rejection and allowance of the claims.

Claims 2-7 and 9-13 are believed to be allowable based on dependence from an allowable claim.

Regarding claim 14, the Applicant has amended claim 14 to include the limitation of, “in the event the event related program guide data is available, the remote device displays the program guide data, and,” as shown in FIG. 4 (step 422) and described in the specification Pg. 11, Lines 24-26 of the instant application. This limitation is not taught or suggested by the Darbee reference. Applicant respectfully requests withdrawal of the rejection and allowance of the claims.

Claims 15-20 are believed to be allowable based on dependence from an allowable claim.

Regarding claim 21, the Applicant has amended claim 21 to include the limitation of, "to determine whether event related program guide data is available in a remote device, and, in the event the event related program guide data is available, the remote device displays the program guide data, and, in the event that the event related program guide data is not available" as shown in FIG. 4 (step 422) and described in the specification Pg. 11, Lines 24-26 of the instant application. This limitation is not taught or suggested by the Darbee reference. Applicant respectfully requests withdrawal of the rejection and allowance of the claims.

A

Claims 22-26 are believed to be allowable based on dependence from an allowable claim.

***Claim Rejection – 35 U.S.C. §103***

Claims 27 through 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Darbe et al., U.S. Patent No. 6,130,726 (Darbee). The Applicant respectfully disagrees.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). With respect to claim 27, guide data is displayed by both the first information handling system and the second information handling system, which is not taught or suggested by the submitted reference. The Examiner correctly asserts that "However, Darbee remains silent on the [sic] being capable of displaying program content and displaying program guide data on the television receiver or set-box (first display)." B

The Examiner then asserts various portions of the Darbee reference for support of displaying guide data on a first device. For example, the Examiner first asserts Col. 1, Lines 29-39, which states the following.

Electronic Program Guides (EPGs) or Interactive Program Guides (IPGs) are application which normally run on a screen of a television set or on a set-top box, with the program guide information appearing on the screen of the television. The problem with this approach is that the guide data must either replace or overlay the program that the user is watching, thus interfering with normal program viewing. This is especially a problem when a group of people is watching the television set and only one of them (usually the one with the remote control) wants to access the program guide. *Darbee, Col. 1, Lines 29-39*.

This section teaches the undesirability of showing guide data on a first device. Indeed, Darbee even gives an extensive listing of patents, and then asserts the following.

However, in all instances, the program data is limited to information concerning a particular song or video title that is being or may be broadcast, and there is no suggestion that the program data could or should include graphic program scheduling or advertising data. A typical program message includes, for example, information concerning the composer, track title, the artist and the album associated with the track title. *Darbee, Col. 2, Lines 17-22*

Thus, Darbee suggests that in “all instance”, the data is only displayed on the viewing device, because “those skilled in the art failed to fully appreciate the usefulness of a remote control device.” *Darbee, Col. 2, Lines 27-29*. To address these problems, Darbee provides data on the remote control unit 10, and NOT the viewing device, i.e., television, and teaches away from displaying data on the viewing device, “without causing an interruption in content that is being depicted on an associated television monitor.” *Darbee, Col. 2, Lines 48-49.*

However, the present claimed invention claims displaying the guide data on BOTH the first information handling system and the second information handling system. “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” *M.P.E.P. 2131.02, citing W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). In the present case, the Examiner’s proposed modification to the *Darbee* reference would change the reference in such a way as to be contradictory to the problem it is trying to solve, as stated by the reference itself. The submitted reference, including the submitted portions, fail to teach or suggest the display of guide data on BOTH the first information handling system and the second information handling system.

Therefore, it is respectfully submitted that a *prima facie* showing of obviousness has not been established, and withdrawal of the rejection is respectfully requested.

**CONCLUSION**

In light of the forgoing, reconsideration and allowance of the claims is earnestly solicited.

Respectfully submitted,  
Gateway, Inc.

Dated: February 5, 2003

By: 

R. Christopher Rueppell  
Reg. No. 47,045

SUTER & ASSOCIATES PC  
14301 FNB Parkway, Suite 220  
Omaha, NE 68154  
(402) 496-0300      telephone  
(402) 496-0333      facsimile



**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**AMENDMENT**

1. (Twice Amended) A system for displaying program information comprising:
  - a first information handling system capable of being coupled to a first display;
  - a second information handling system capable of being communicatively coupled with said first information handling system, and having a second display disposed on a housing thereof;
    - said first information handling system being capable of displaying program content on said first display;
    - said first information handling system being capable of responding to a predetermined event by communicating event related program guide data to said second information handling system; and
    - said second information handling system being capable of displaying event related program guide data on said second display, wherein said second information handling system receives an input for event related program guide data, the second information handling system determines whether event related program guide data is available in the second information handling system, and, in the event the event related program guide data is available, the second information handling system displays the program guide data, and in the event the event related program guide data is not available, the second information handling system sends a request for the program guide data to the first information handling system.
  
8. (Twice Amended) A system for displaying program content and program guide data, comprising:
  - means for receiving program content and program guide data;
  - first means, coupled with said receiving means, for displaying the program content;
  - means for obtaining program guide data related to an event from said receiving means in response to the event; and

second means, coupled with said obtaining means, for displaying the event related program guide data obtained from said receiving means, wherein an input for event related program guide data is received and a determination made as to whether program guide data is available to the second means, and in the event the event related program guide data is available, the second information handling system displays the program guide data, and, in the event the event related program guide data is not available, the obtaining means sends a request for the program guide data.

14. (Twice Amended) A method for displaying program guide data, comprising:

receiving an input for event related program guide data;

determining whether the event related program guide data is available in a remote device, and, in the event the event related program guide data is available, the remote device displays the program guide data, and, in the event the event related program guide data is not available;

sending a request for program guide data to a host device, whereby the event related program guide data requested corresponds to the received input;

upon receiving the request, fetching event related program guide data;

transmitting the event related program guide data to a remote4 device; and

upon receiving the event related program guide data, displaying at least a portion of the event related program guide data on a first display of the remote device such that event related program guide data may be viewed independently from program content.

21. (Amended) A program of instruction storable on a computer readable medium capable of causing an information handling system to execute steps for displaying program guide data, the steps comprising:

upon occurrence of an event, receiving an input for causing an information handling system to determine whether event related program guide data is available in a remote device, and, in the event the event related program guide data is available, the remote device displays the program guide data, and, in the event that the event related program guide data is not available to fetch event related program guide data from the database;

transmitting the event related program guide data from the information handling system to the remote device via a communications link between the information handling system and the remote device;

storing the transmitted event related program guide data in a memory of the remote device; and

displaying at least a portion of the event related program guide data stored in the memory on a first display disposed on a housing of the remote device.

31. (Amended) A method for displaying program information comprising:

upon occurrence of an event, sending a request for program guide data to a second information handling system from a first information handling system;

upon receiving the request, fetching event related program guide data;

transmitting the event related program guide data to the first information handling system; and

upon receiving the event related program guide data, displaying at least a portion of the event related program guide data on a first display of the first information handling system, wherein said event related program guide data on said first display corresponds to electronic program guide data displayed on a second display of said second information handling system.

35. (Amended) The method as claimed in claim 31, further comprising determining whether the event related program guide data is available in the first information handling system, and in the event the event related program guide data is not available, executing said sending step.